

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARNO WIRZ

Appeal No. 96-2850
Application 08/015,400¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, and
COHEN and McQUADE, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's rejection of claims 2, 4, 5 and 7. No other claims are pending in the application.

¹ Application for patent filed February 9, 1993. According to appellant, the application is a continuation-in-part of Application 07/785,034, filed October 30, 1991.

Appeal No. 96-2850
Application 08/015,400

The invention disclosed in appellant's application relates to an offset printing machine in which a foil 4 is disposed on an impression cylinder 7 to compensate for an eccentric outer cylindrical surface of the cylinder.²

Claims 2 and 4 are the only independent claims on appeal. Both of these claims recite that the foil has "means for adjusting to and compensating for irregularities in the shape of respective parts of the outer cylindrical surface of the impression cylinder." Claim 2 additionally recites that the foil is "chosen from a plurality of foils of varying thickness."

A copy of the appealed claims is appended to appellant's brief.

² The body of each of the independent claims 2 and 4 is inconsistent with the preamble in that the body calls for the combination of the foil and the impression cylinder, whereas the preamble is directed to the impression cylinder per se. Correction of this inconsistency is in order in the event of further prosecution before the examiner. For the purpose of reviewing the examiner's rejections we have interpreted the claimed subject matter to be directed to the combination of the foil and the impression cylinder.

Appeal No. 96-2850
Application 08/015,400

The following references are relied upon by the examiner as evidence of obviousness in support of his rejections under 35 U.S.C. § 103:

Wirz et al. (Wirz)	4,327,135	Apr. 27, 1982
Kobler et al. (Kobler)	4,681,035	Jul. 21, 1987
Wirz ³ (German Offenlegungsschrift)	24 46 188	
Apr., 1976		

The grounds of rejection are as follows:

1. Claims 2 and 7 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as his invention.

2. Claims 2, 4 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over the German Wirz reference in view of Kobler.

³ Translation attached.

3. Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over the references applied in the rejection of claim 4 above and further in view of the U.S. Wirz patent.

4. Claim 7 additionally stands rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth on the fifth page of the examiner's answer.⁴

The rejection of claim 7 under the first paragraph of § 112 was first introduced in the examiner's answer and is stated to be a new ground of rejection. The answer on the last page thereof also states that a failure to respond to this new ground of rejection ?will result in dismissal of the appeal of the claims [sic, claim] so rejected.? Since no response to this new ground of rejection is found in the record before us, we herewith dismiss the appeal as to claim 7, thus leaving for our consideration the standing rejections of claims 2, 4 and 5.

⁴ The pages in the examiner's answer are unnumbered.

Appeal No. 96-2850
Application 08/015,400

With regard to the rejection of claim 2 under the second paragraph of § 112, the examiner's difficulty with the claim language centers on the recitation that the foil on the impression cylinder is chosen from a plurality of foils of varying thickness. As discussed on the third and eighth pages of the answer, the examiner's position, in substance, is that the recitation that the foil on the cylinder is chosen from the claimed plurality of foils obscures the scope or metes and bounds of the claimed subject matter in that it is unclear whether the claim is limited to one foil or to a plurality of foils.

Appellant has not expressly challenged the examiner's position as outlined supra. Instead, appellant's only response to the examiner's rejection of claim 2 under the second paragraph of § 112 is that "we [sic] do not recite a plurality of foils as much as we [sic] recite the varying thickness of the different foils." This argument begs the question as to whether claim 2 is limited to one foil or to a plurality of foils. The fact that the claim may refer to a "varying thickness" does not detract from the fact the claim explicitly

Appeal No. 96-2850
Application 08/015,400

states that there are a "plurality of foils" and that the foil on the impression cylinder is chosen from the claimed plurality of foils.

Furthermore, the recitation that there are "a plurality of foils of varying thickness" is ambiguous and hence indefinite in that it is unclear whether each foil in the plurality of foils is required to be of "varying thickness" or whether the thickness of each foil is required to be different from the thickness of each of the other foils making up the plurality of foils.

For the foregoing reasons, we will sustain the examiner's rejection of claim 2 under the second paragraph of § 112.

Turning now to the § 103 rejection of claims 2, 4 and 5, the examiner concedes that the German Wirz reference does not contain a teaching that the foil 1 on the printing cylinder 17 compensates for irregularities in the outer cylindrical surface of the cylinder. He nevertheless concludes:

It would have been obvious to one of ordinary skill in the printing art to provide the foil of Wirz with a varying thickness in view of Kobler et al. to compensate for non-uniform rotation of the cylinder thereby achieving clear printed images. [Answer, fourth page].

We cannot sustain the § 103 rejection of claims 2, 4 and 5. The foil in the German Wirz reference is merely used to reduce the build-up or accumulation of dye on the printing cylinder in the embodiment of Figure 5.

The Kobler reference, on the other hand, does not disclose a "foil" as such. Nor is it concerned with the problem of eccentricity or other irregularities in the shape of the outer cylindrical surface of a printing or impression cylinder.

Instead, the Kobler reference addresses the problem arising from oscillations or vibrations of blanket cylinders which act as impression or printing cylinders, causing non-uniform printing pressure between opposing blanket cylinders. To overcome this problem, Kobler teaches the art to thicken a

blanket underlay 13, which is disposed between an outer rubber blanket 30 and the periphery of the oscillating blanket cylinder, in regions where the blanket cylinder exhibits reduced printing pressure to make the printing pressure more uniform. Such a teaching would not have suggested the examiner's proposed modification of Wirz' foil 1 for solving a problem not recognized or addressed by either of the applied references. If anything, Kobler suggests the concept of providing one of Wirz' blanket cylinders 13, 16 with an underlay having increased thickness in certain regions to compensate for oscillations of the cylinder. Such a suggestion, however, would not arrive at the claimed invention.

In the final analysis, the only way the examiner could have arrived at his conclusion of obviousness is through hindsight based on appellant's teachings. Hindsight analysis, however, is clearly improper. In re Deminski, 796 F.2d 436, 443, 230 USPQ 313, 316 (Fed. Cir. 1986).

In summary, the appeal as to claim 7 is dismissed, the

Appeal No. 96-2850
Application 08/015,400

rejection of claim 2 under the second paragraph of § 112 is affirmed, and the rejection of claims 2, 4 and 5 under § 103 is reversed.

The examiner's decision rejecting appealed claims 2, 4 and 5 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

)	
HARRISON E. McCANDLISH, Senior)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
IRWIN CHARLES COHEN)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	

Appeal No. 96-2850
Application 08/015,400

JOHN P. McQUADE)
Administrative Patent Judge)

Herbert L. Lerner
1200 South Federal Highway
Hollywood, FL 33020